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Our Case No. 8285/283

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Theodore James Myers et al.)	
)	Examiner: Alexander G. Kalinowski
Serial No. 09/391,427)	
)	Group Art Unit No. 3626
Filing Date: September 8, 1999)	
)	
For Combination Reservation and)	
Navigation System and Method)	
Therefor)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

Applicants request review of the final rejection that was mailed March 22, 2006 in the above-identified application. No amendments to the claims are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

I. Introduction

Claims 12-15, 17-22, 24-25, 38-43, 59-63 and 66-68 stand rejected under 35 U.S.C. 112, first paragraph, for allegedly failing to comply with the enablement requirement. Claims 12, 13, 18-21 and 38-42 stand rejected under 35 U.S.C. 103 as being unpatentable over Zeitman (U.S. Patent No. 5,940,481) in view of Yoshida (U.S. Patent No. 5,877,704) and Walker (U.S. Patent No. 5,794,207). Claims 15 and 22 stand rejected under 35 U.S.C 103(a) as being unpatentable over Zeitman, Yoshida and Walker and further in view of Sehr (U.S. Patent No. 6,085,976). Claims 43 and 59-63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zeitman, Yoshida and Walker et al. and further in view of DeLorme et al. (U.S. Patent No. 5,948,040). Claims 67-68 stand rejected under 35 U.S. C. 103(a) as being unpatentable over Zeitman, Yoshida, and Walker et al. in view of DeLorme.

II. All of the claims are enabled

The pending claims are enabled, including for the recited feature of negotiating with a reservation communication device for a good or service desired by a customer, responsive to a reservation communication device auctioning the good or the service to the customer, where the auctioning allows for at least one offer and at least one counteroffer.

An analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. MPEP 2164.01. The test is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. MPEP 2164.01. The fact that experimentation may be complex does not necessarily make it undue. *Id.*

People skilled in the pertinent art of the present application may include telecommunications personnel and computer programmers. In cases involving both the art of computer programming and other technologies, “the examiner must recognize that

the knowledge of persons skilled in both technologies is appropriate criteria for determining sufficiency.” MPEP 2106.02.

The invention relates to a reservation communication device in a combination reservation and navigation system. The application includes a block diagram, flowcharts, and accompanying descriptions to describe the combination reservation and navigation system. It is typical for computer applications to represent system components in block diagram format to represent the elements of the system and functions. MPEP 2106.02. The application discloses that a good or service may be auctioned to customers responsive to negotiations between the reservation communication device (102) and the customers for the good or the service. The specification states that the auction includes offers and counter offers between both parties in an attempt to reach an agreement. The auction also permits various businesses to be more aggressive with their business depending on various business factors, such as time of day, week and year, volume of activity and any given time, special promotions, etc. Spec., page 15, lines 18-23.

The Office Action states that “the originally filed specification fails to define the terms auction and counteroffer, and further does not contain an enabling disclosure for this feature as claimed and defined.” March 21, 2006 Final Office Action, pg. 3. There is no such obligation, however, to provide a definition of the terms in the specification. The MPEP is clear the “the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification.” MPEP 2111.01. Moreover, a patent need not teach, and preferably omits, what is well known in the art. *See In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991). Since Applicants did not provide their own definition of the terms auction and counteroffer, Applicants respectfully request that the plain meaning of the terms be accorded to them.

The Office Action goes on to incorrectly state that “there is no disclosure of how the reservation communication device utilizes the offer and counteroffers in auction.” March 21, 2006 Final Office Action, pg. 3. The block diagram of Fig. 1 illustrates that the combination reservation and navigation system 100 generally includes a reservation communication device (102). Spec. page 4. The reservation communication device

(102) is a computer device operated by a reservation service company, an individual customer, a business and a navigation service company. Spec. page 5. Fig. 2 is a flowchart 200 to illustrate a method performed by the reservation communication device (102) of Fig. 1. Spec. page 15. Included in the method is step 208 which describes that the good or service may be auctioned to the customers responsive to negotiations between the reservation communication device (102) and the customers for the good or the service. Spec. page 15. There are at least twelve pages of specification to go along with Figs. 1 and 2 to describe an operation of the reservation communication device (102). Included in the description is the use of offers, counteroffers and an auction.

The Office Action also incorrectly states that there is no disclosure of whether the reservation communication device actually makes counteroffers or offers and there does not appear to be an indication in the specification that the reservation communication device offers the good or service to the highest bidder. In Fig. 1, the reservation communication device (102) is shown connected with a customer communication device 104. Fig. 3 illustrates a flowchart 300 describing a method performed by the customer communication device (104) which “may negotiate with the reservation communication device [102] for the good or the service desired by the customer responsive to the reservation communication device auctioning the good or the service to the customer.” Spec. page 17.

To make and use the invention, a telecommunication person could build the system shown in Fig. 1 and a computer programmer could write computer code to implement the steps of Figs. 2-5, along with the twenty-five pages of accompanying description. There is no reason to believe that the figures and the description are not detailed enough to allow the telecommunications person and the computer programmer to implement the claimed system without undue experimentation. The Office Action goes on to ask questions about how specific made-up example, not claimed, would be performed. It is clear, however, that there is no statutory requirement for the disclosure of all specific examples. MPEP 2165.01(II). The Office Action has not shown that a person skilled in the art would not be able to make and use the claimed invention without

resorting to undue experimentation. *See* MPEP 2106.02. Indeed, as described above, the specification as filed properly contains enabling disclosure for the features of the reservation system, auction, offer and counteroffer as claimed.

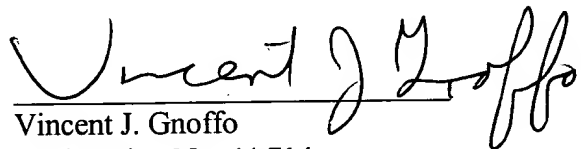
III. The claims should be allowed over the cited references

Regarding the prior art rejections over three and four references, as noted in our previous responses, including Amendment F, none of the references, alone or in combination, disclose or suggest at least the feature of the independent claims of auctioning the good or the service to the customer, wherein the auctioning allows for at least one offer and at least one counteroffer. Moreover, there is no motivation to combine the parking management system and parking-site reservation control system of Zeitman and Yoshida, with the cryptographically assisted commercial network system, travel reservation information and planning system, and driver's license card of Walker et al., DeLorne et al. and Sehr. For at least these reasons, Applicants respectfully request that the rejection to the claims be withdrawn.

IV. Conclusion

For at least the above reasons, Applicants respectfully request review of the final rejection directed against the current application and withdrawal of the rejections against the claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Vincent J. Gnoffo", written over a horizontal line.

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